

Remarks

Claims 1-17 were previously pending in the subject application. By this amendment, the applicants have canceled claims 1-17 and have added new claims 18-21. No new subject matter has been added by this amendment. The applicants respectfully submit that the cancellation of claims as set forth herein is done for the sole purpose of expediting prosecution and should not be taken to indicate the applicants' acquiescence in, or agreement with, the rejections set forth in the outstanding Office Action.

The applicants acknowledge that the subject matter of claim 17 is withdrawn as being directed to a non-elected invention. By this Amendment, the non-elected subject matter has been canceled without prejudice. Accordingly, claims 18-21 are now before the examiner for consideration. Favorable consideration of the claims now presented in view of the remarks and amendments set forth herein, is earnestly solicited.

As an initial matter, the Office Action states that the oath or declaration is defective. Please note that the Declaration and Power of Attorney submitted in the subject application is identified by the serial number and the filing date. The Declaration and Power of Attorney also recites the unsigning inventor's name and address as last known when the Declaration and Power of Attorney was prepared and executed by the two signing applicants. Accordingly, the Declaration and Power of Attorney, as submitted to the Patent Office, is in compliance with 37 C.F.R. 1.67(a). The applicants respectfully request reconsideration and withdrawal of this objection.

Claims 1-16 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The applicants appreciate the Examiner's careful review of the claims and suggestions for adding greater clarity to the claimed subject matter. Please note that, by this amendment, claims 1-16 have been canceled thus rendering moot this grounds for rejection. New claims 18-21 have been drafted taking into account the issues raised in the outstanding Office Action. The applicants respectfully submit that new claims 18-21 are sufficiently precise so as to reasonably apprise one skilled in the art of the metes and bounds of the claimed subject matter. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejections set forth under 35 U.S.C. §112, second

paragraph.

Claims 6 and 9 have been rejected under 35 U.S.C. §102(b) as being anticipated by Izhar *et al.* (U.S. Patent No. 5,444,179). Please note that claims 6 and 9 have now been canceled thus rendering moot this grounds for rejection. To the extent that this grounds for rejection might be applied to new claims 18-21, the applicants respectfully traverse this grounds for rejection because the Izhar *et al.* patent does not teach or suggest the current applicants' advantageous method for inducing flowering in strawberry plants.

It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

The Izhar *et al.* reference does not disclose or suggest a method for inducing the flowering of strawberry plants wherein the plants are maintained for more than six weeks at daytime temperatures which are at least 30°C, followed by a second period wherein the daytime temperature does not exceed 20°C. Accordingly, reconsideration and withdrawal of this rejection under 35 U.S.C. §102(b) is respectfully requested.

Claims 1-3, 5-12, and 14-16 have been rejected under 35 U.S.C. §102(b) as being anticipated by Heide (1976). Please note that these claims have been canceled thus rendering moot this grounds for rejection. To the extent that these grounds for rejection might be applied to new claims 18-21, the applicants respectfully traverse these grounds for rejection because the Heide reference does not

teach or suggest the current applicants' advantageous method for inducing flowering in strawberry plants.

As noted above, the currently pending claims recite specific temperature limitations and time periods. The Heide reference does not disclose or suggest these specific temperature limitations or time periods. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) based on the Heide reference.

Claims 1-3, 5, 6, 8-12, 15, and 16 have been rejected under 35 U.S.C. §102(b) as being anticipated by Sonstebly (1997). Please note that these claims have been cancelled thus rendering moot this grounds for rejection. To the extent that these grounds for rejection might be applied to new claims 18-21, the applicants respectfully traverse this grounds for rejection because the Sonstebly reference does not disclose or suggest the applicants' claimed method and because the Sonstebly reference is not available as prior art under 35 U.S.C. §102(b) against the current claims because it was published less than one year before the applicant's filing date.

A proper rejection under 35 U.S.C. §102(b) requires that the cited reference be available to the public more than one year prior to the date of the application. Please note that the subject application claims the priority of provisional application 60/061,969 filed on October 14, 1997. The Sonstebly reference was published in September 1997 and was not available to the public more than one year prior to the filing date of the subject application. Consequently, the Sonstebly reference does not constitute a statutory bar. Therefore, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) based upon the Sonstebly reference.

Claims 1-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable in view of either Heide or Sonstebly, in view of the Izhar *et al.* patent. The applicants respectfully traverse this rejection because the cited references, alone or in combination, do not teach or suggest the unique and advantageous strawberry growth system as claimed by the current applicants.

The present invention provides the surprising discovery that temperature during the daylight hours can be manipulated in a specific way in order to initiate flowering in strawberries. Thus, the

method of the subject invention can be used to provide increased production of strawberries at the desirable peak period of the year by inducing flowering of the strawberry plant.

The Office Action acknowledges that the processes taught by either the Heide or the Sonsteby references differ from the subject application with respect to the temperatures employed. Also, the Heide and Sonsteby references teach reducing both temperatures and photoperiods to enhance flowering in strawberry plants. The applicants respectfully submit neither the Heide nor the Sonsteby references teach or suggest the claimed invention. Thus, the processes disclosed in the Heide and Sonsteby references fail to make obvious the claims of the subject invention.

The Izhar *et al.* patent describes a new type of strawberry plant that may be induced to flower by subjecting it to night temperatures up to about 26°C. It fails to describe subjecting strawberry flower plants to day temperatures of about 30°C followed by day temperatures which do not exceed 20°C. Thus, the Izhar *et al.* reference does not remedy the defects previously noted in the Heide and Sonsteby references.

The applicants respectfully submit that there is no suggestion or motivation in the prior art references that would lead a person skilled in the art to arrive at the subject invention. As a matter of law, a finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. The mere fact that the purported prior art could have been modified or applied in a manner to yield the applicants' invention would not have made the modification or application obvious unless the prior art references suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art" *In re Dow Chemical Co.*, *supra* at 1531. As shown by the foregoing remarks, neither the Heide nor the Sonsteby references provides the suggestion nor the expectation of success in subjecting strawberry plants to either day or night temperatures of about 30°C.

An assertion of obviousness without the required suggestion or expectation of success in the prior art is tantamount to using applicants' disclosure to reconstruct the prior art references to arrive

at the subject invention. This was specifically recognized by the CCPA in *In re Spinnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

Here, it is only the applicants' disclosure that provides the teaching to expose strawberry plants to day temperatures of 30°C and to then reduce the day temperatures to below 20°C, and the applicants' disclosure cannot be used to reconstruct the prior art references for a rejection under §103. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

In view of the foregoing remarks and the amendment above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

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Docket No. UF-206X
Serial No. 09/172,689

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachments: Petition and Fee for Extension of Time